

Remarks

Claims 36-42 and 51-56 are pending in the application. Claims 36 and 56 have been amended. The pending claims stand rejected as failing to comply with the written description requirement of the first paragraph of 35 U.S.C. 112. Reconsideration of the application in view of the amendments and the remarks to follow is requested.

Claims 36 and 56 have been amended to recite, for example an elongated solid iron mass. In the final office action the Examiner did not see, in the specification or original claim language, support for an elongated iron mass as recited in claim 36. However, exact terms need not be used in haec verba to satisfy the written description requirement of the first paragraph of 35 U.S.C. 112. *Eiselstein v. Frank*, 52 F.3d 1035, 1038, 34 USPQ2d 1467, 1470 (Fed. Cir. 1995); *In re Wertheim*, 541 F.2d 257, 265, 191 USPQ 90, 98 (CCPA 1976). See also 37 CFR 1.121(e) which merely requires substantial correspondence between the language of the claims and the language of the specification. MPEP §1302.01. Amendments to an application which are supported in the original description are NOT new matter. Mere rephrasing of a passage does not constitute new matter. *In re Anderson*, 471 F.2d 1237, 176 USPQ 331 (CCPA 1973).

At page 4 of the specification, "a process is provided for preparing halogenated alkanes by reacting a haloalkane and a haloalkene in the presence of a metal chelating agent and iron to produce the a halogenated alkane." By way of example on the following page, "193 grams of iron wire were added to the reactor." As amended, claim 36 recites "an elongated solid iron mass" which is substantially corresponds, as the law

requires, to iron wire. As such the amendment to claim 36 is supported by the specification and does not constitute new matter.

The Examiner is further directed to claim 56 which recites that the elongated solid iron mass comprises iron wire. As described above, there can be no doubt that "iron wire" is supported by the specification for at least the reason it is literally recited in the specification. As such, claim 56 is allowable.

Claims 36-42 and 51-56 are pending in the present application. This application is now believed to be in immediate condition for allowance, and action to that end is respectfully requested.

Respectfully submitted,

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By: 

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